

REMARKS

Claims 1-4, 6-7, 9-17, 20-42, 44 46-48 and 51-52 are pending in the application. Claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51-52 are rejected.

Reconsideration is requested. The rejections are traversed. No new matter is added. No claims are amended. Claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, 51 and 52 remain in the case for consideration.

INTERVIEW SUMMARY

A telephonic interview was held on Wednesday, September 26, 2007 at 1:00 p.m. Eastern Time. Participating in the interview were Examiner Jude Jean-Gilles and Applicant's representatives Ariel Rogson and David Crowther. The participants discussed whether a motivation to combine the cited references existed based on Applicant's position that the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. No agreement was reached on this matter. Further, the participants discussed the prior art rejection of the claims, in particular, claim 52. The Examiner indicated that the Applicant's arguments "seemed valid" with respect to claim 52. However, no formal agreement was reached.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

Claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,721,784 B1 to Leonard, et al ("Leonard") in view of US Patent No. 6,272,484 B1 to Martin, et al. ("Martin"). The Applicant respectfully traverses the rejections.

I. General discussion of the references

A. US Patent No. 6,721,784 B1 to Leonard, et al ("Leonard")

Leonard teaches an electronic mail system with a viewer applet capable of viewing an electronic mail message. The viewer applet and the electronic mail message are—by design—kept as separate elements and do not comprise a single file. The electronic mail message can only be displayed by the viewer applet. One of the purposes of keeping the viewer applet and

the message as independent elements is to control viewing and handling of the message by encrypting the message prior to transmitting the message to the viewer applet. The basic concept involves the ability to encrypt the message such that only the viewer applet has the ability to decrypt the message, thereby providing control over the viewing and handling of the message.

In the detailed description, Leonard elaborates on the independence of the viewer applet with respect to the message:

The basic concept underlying this embodiment of the invention is to control viewing and handling of the electronic mail message by retaining the message on the electronic mail server 1 and requiring the recipient to view the message using the viewer applet 4, which permits only the functions indicated by the originator of the message. Use of the viewer to view the message is ensured by encrypting the message and transmitting the message to the viewer applet, with only the viewer applet having the ability to decrypt the message. . . .
(Leonard, column 14, lines 51-60)

Leonard teaches that the only place that the message permanently exists is on the electronic mail server (*see, e.g.*, Leonard, column 14, lines 61-64, *emphasis added*). The message is then viewed by “transmitting the message to the installed viewer applet 7 on the forwarded message recipient’s computer” (Leonard, column 16, lines 14-16). The viewer applet retains only “transient storage” of the message in memory (*see, e.g.*, Leonard, column 14, lines 60-61, and claim 23) such that when the “permanently” stored message is erased from the electronic mail server, the server “expunges the message from existence” (*see, e.g.*, Leonard, column 14, lines 62-64). If in Leonard the message and the viewer applet comprised a single file, any person with the single file in possession could decrypt and view the message, which would defeat the purpose of maintaining control over viewing of the message. Thus, an essential feature of Leonard is that the message and the viewer applet do not comprise a single file, thereby providing control over the viewing, handling, decryption, and deletion of the message.

B. US Patent No. 6,272,484 B1 to Martin, et al. (“Martin”)

Martin teaches a method for creating a thumbnail representation of a web page (*see, e.g.*, Martin, abstract). The thumbnail representation is generated from an image file, which is captured from a displayed visual representation of the web page (*see, e.g.*, Martin, abstract). By selecting the thumbnail representation, a user may “access either the web page at the first location or access the image file stored at the second location” (Martin, abstract, lines 13-14).

The image file is compressed using known techniques such as Joint Photographic Experts Group (JPEG), Graphics Interchange Format (GIF), Tagged Image File Format (TIFF), or “other known graphics formats” (*see* Martin, column 7, lines 8-11). The user may create a “self-contained executable viewing application” to view the image file, and may then provide “another user with a copy of stored image file 601 or the self-contained executable viewing program 623” (*see* Martin, column 10, lines 27-33). This allows one user to provide the image file to another user instead of providing a Uniform Resource Locator (URL) of the web page. In such a manner, the other user can view the visual representation of the web page without having Internet access (*see, e.g.,* Martin, column 9, lines 15-29).

II. Combining Martin with Leonard is improper for at least the reasons of (A) a lack of motivation or a reason to combine, (B) a teaching away by the prior art of combining elements of the references, and (C) an improper use of hindsight bias

A. It would not have been obvious to a person with ordinary skill in the art, at the time the invention was made, to combine the teachings of Martin with Leonard

The Examiner states that the image viewer of Martin combined with the electronic mail system of Leonard teach each of the limitations of claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51-52. The Examiner suggests that a motivation to combine is provided by Leonard for the purpose of “allowing control of viewing and handling of the electronic field message and allowing the user to view the message using the applet viewer” (*see, e.g.,* Office Action, page 3-4, citing Leonard, column 14, lines 58-62). It is also suggested that Martin provides a motivation to combine in that “this method should enable a first user to provide a second user with a web page image as originally viewed by the first user” (*see, e.g.,* Office Action, page 4, citing Martin, column 2, lines 58-62). The Applicant respectfully disagrees.

1. *KSR International Co. v. Teleflex Inc.* rejects a narrow, rigid analysis of obviousness, but nevertheless maintains important longstanding precedent

In *KSR International Co. v. Teleflex Inc.*, the U.S. Supreme Court revisited the standard for obviousness. *See, e.g., KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). In *KSR*, the plaintiff Teleflex sued the defendant KSR for patent infringement pertaining to an

adjustable automobile pedal. *Id.* The Court held that obviousness should not be analyzed “in a narrow, rigid manner inconsistent with § 103 and our precedents.” 127 S. Ct. at 1746.

Accordingly, the Court remanded the case for further proceedings. *Id.*

Notwithstanding the Court’s clear warning about applying a narrow, rigid analysis to the issue of obviousness, the Court discussed various longstanding principals with respect to obviousness. For example, the Court established that the “teaching, suggestion, or motivation” (TSM) test developed in 1961 by the Court of Customs and Patent “captured a helpful insight.” *KSR*, 127 S. Ct. at 1741, citing *Application of Bergel*, 48 C.C.P.A. 1102, 292 F.2d 955, 956-957 (1961). Noting that the Court of Appeals has applied the TSM test in many cases, the *KSM* Court stated that “[t]here is no inconsistency between the idea underlying the TSM test and the *Graham* analysis.” *KSR*, 127 S. Ct. at 1741. The *KSM* Court went on to explain that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* Thus, the Court warned against using a “rigid approach” (*see, e.g., KSR*, 127 S. Ct. at 1739), but nonetheless preserved the helpful insight of the TSM test.

Furthermore, in determining whether there was an apparent reason to combine previously known elements, the Court emphasized that “the analysis should be made explicit.” *KSR*, 127 S. Ct. at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (C.A. Fed., 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Here, the Examiner suggests that a motivation to combine the teachings of Martin with those of Leonard stems from a desire to control the viewing and handling of the electronic field message and to allow the user to view the message using the applet viewer. But such a statement lacks a rational underpinning to support a legal conclusion of obviousness. Leonard teaches that a basic concept is to control the viewing and handling of the message. The basic concept is primarily accomplished by encrypting the message such that only a person with the applet viewer can view the message. The Examiner has not articulated a reason why a person of ordinary skill in the art would combine the teachings of Martin with those of Leonard in light of their conflicting purposes. Indeed, Martin allows a first user to provide a second user with a web page

image as originally viewed by the first user. As such, the purpose of Martin is to facilitate others to view the web page—not to prevent such acts.

It is rational for Martin to have an image viewer transferred with the image for the purposes of viewing the web page. But it would not be rational to combine that teaching with Leonard's teachings because the ability to control the viewing and the handling of the message would be lost, thereby revealing the encrypted message to any person who happens to intercept the message. Thus, there lacks an apparent reason to combine the references. In light of the conflicting teachings of Leonard and Martin, the Examiner has not made the obviousness analysis explicit, nor has the Examiner provided a rational underpinning to support a legal conclusion of obviousness.

2. Under MPEP 2143.01(V), the proposed combination renders Leonard unsatisfactory for its intended purpose

Under MPEP 2143.01(V), if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." As described by Leonard, it is a "basic concept" of the Leonard invention that a message and a viewer applet do not comprise a single file (*see, e.g.*, Leonard, column 14, lines 51-60, column 14, lines 61-64, and column 16, lines 14-16). Separating the message and the viewer permits "control" of the "viewing and handling" of the message, such as by encrypting the message. The vulnerability of the message when encrypted and attached to the viewer that can decrypt it is that it defeats the "control" aspect of Leonard, which is the purpose. Encryption is a form of control emphasized throughout Leonard (*see, e.g.*, column 1, line 37, column 3, lines 60-65, column 8, lines 7-13, column 11, lines 43-67, column 12, lines 1-9, column 12, lines 51-62, column 13, lines 7-21 and 33-39, column 14, lines 51-62, column 16, lines 55-67, column 17, lines 1-44, column 21, lines 38-52, and column 22, lines 6-28). The combination of Martin and Leonard would render the primary form of "control" ineffective. Indeed, combining the image viewer of Martin with the message of Leonard would render Leonard's invention unsatisfactory for its intended purpose.

If the message of Leonard included the image viewer as taught by Martin, there would be no (separate) viewer applet. And if the viewer applet is included with the message, then anyone who receives the message automatically receives the viewer applet, and is therefore able to view

the message—including people who were not meant to view the message (because of the encryption). The encryption of Leonard, used to prevent persons without the proper viewer from viewing the message, would be rendered pointless by the combination with Martin—and the “basic concept” of Leonard, as described at column 14, lines 51-61, would be defeated.

B. The prior art references teach away from combining elements of the references

Similarly, while discussing *United States v. Adams*, the KSR Court highlighted the “principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR*, 127 S. Ct. at 1740, citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966). The Applicant submits that the motivation to combine cited by the Examiner of “allowing control of viewing and handling of the electronic field message and allowing the user to view the message using the applet viewer” in actuality shows that Leonard teaches away from combining the references. Leonard suggests that the message and the viewer applet operate independently because of the need to control viewing and handling of the electronic message (*see, e.g.*, Leonard, column 14, lines 51-60, column 14, lines 61-64, column 16, lines 14-16). This, as a result, teaches away from combining the references.

Even if a decryption applet were maintained separately from the viewer applet (which runs counter to the teaching of Leonard in that the encryption/decryption feature is integral to the viewer, *see* Leonard column 14, lines 59-60), the teachings of Martin would be rendered inoperable. Specifically, a first user would be unable to provide a second user with a web page image as originally viewed by the first user, because the second user, lacking the decryption applet, would be unable to decrypt the message. In other words, a separate decryption applet would still be required to access the combination of the viewer applet and the encrypted message. And because requiring a separate decryption applet conflicts with the teachings of Martin (*i.e.*, enabling a first user to provide a second user with a web page image as originally viewed by the first user), the prior art references teach away from combining elements of the references.

C. The Examiner improperly employs hindsight bias

The KSR Court referred to its previous ruling in *Graham v. John Deere Co. of Kansas City*, stating that “[a] factfinder should be aware . . . of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR*, 127 S. Ct. at 1742, citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36 (1966). The Court used *KSR* to caution against applying a hindsight bias analysis too rigidly (see 127 S. Ct. at 1742-1743), but retained the notion that factfinders should be aware of such hindsight bias distortion. *Id.* at 1742. Under 35 U.S.C. 103(a), the point of reference is at “the time the invention was made.” The Applicant submits that combining Martin with Leonard requires the use of hindsight—it would not have been obvious at the time the invention was made to have combined the references. Though the possibility of combining a message with a viewer in a single file may seem more plausible in light of the present application, such reliance succumbs to the distortion caused by hindsight bias.

Further, only knowledge “within the level of ordinary skill at the time the claimed invention was made” should be used in an obviousness analysis, and not knowledge that is “gleaned” from the Applicant’s disclosure to reconstruct a motivation to combine. See, e.g., *In re McLauphlin*, 170 U.S.P.Q. 209, 212 (1971). That the present application discloses teachings that include a message and a viewer comprising a single file does not make it proper to glean this information to find a motivation to combine references, especially in light of the disclosure of Leonard, which teaches away from the very notion. Thus, the Applicant submits that the Examiner employed improper hindsight when alleging that the teachings of Martin could be combined with the teachings of Leonard.

- D. Claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51-52 are patentable over Leonard in view of Martin and the claims should therefore be allowable

Combining Martin with Leonard is improper for at least the reasons set forth above, which include a lack of motivation or a reason to combine, a teaching away by the prior art of combining elements of the references, and an improper use of hindsight bias. The combination of Leonard and Martin would render Leonard unsatisfactory for its intended purpose; thus, there is no motivation to combine the references as suggested. Since this combination forms the basis of all rejections in this Office Action, the Examiner has failed to make a *prima facie* argument that the claims are unpatentable under 35 U.S.C. § 103(a) over Leonard in view of Martin. Thus,

claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51-52 are patentable over Leonard in view of Martin and the claims should therefore be allowable.

III. Leonard and Martin fail to teach each of the limitations of each of the claims of the present application

A. Leonard fails to teach that the message and the viewer comprise a single file

The Examiner states that the “origination software 2” and the “viewer applet 4” of Leonard (*see, e.g.*, Figure 1) may be integrated into a single program or applet (*see, e.g.*, Office Action, 2/9/2007, page 3); the implication is that this is equivalent to the viewer applet being contained with the message itself in a single file. However, neither the origination software 2 nor the viewer applet 4 is a message: they are both tools that support operations on a message. Leonard does not teach that the viewer applet is contained with the message itself in a single file.

For example, the function of the origination software tool is to prepare and deliver a message to a server “via a standard electronic mail connection” (*see, e.g.*, Leonard, column 17, lines 18-20). And the viewer applet is a tool for viewing messages (“If a viewer has not already been installed, then the additional steps of installing the viewer applet on the recipient's computer . . . must be performed,” *see, e.g.*, Leonard, column 18, lines 23-27). Even if the origination software tool is combined with the viewer applet tool into a “single program or applet,” the result is just that—a combination of two software tools into one program or applet. This fails to anticipate the inclusion of text and at least one image with a viewer in a single rich media file, as set forth in claim 1.

B. Leonard and Martin fail to teach each of the limitations of claim 52

Claim 52 sets forth:

- a client identifier to identify a creator of the rich media file;
- a unique identifier to identify the rich media file;
- a version number identifying a version of the rich media file;
- a print module to enable printing of the rich media file if included by the creator of the rich media file and to disable printing if excluded by the creator;

a first dialogue box structured to appear responsive to viewing limits of the rich media file, the first dialogue box to communicate to a user an invitation to access another rich media file;

a second dialogue box structured to appear responsive to an update offer, the second dialogue box for prompting the user of the rich media file to check for a newer version of the rich media file;

a requester structured to retrieve the newer version of the rich media file responsive to an action by the user according to the update offer;

information to be displayed on a computer system, the information including text, at least one still image, and structured to include at least one of an animated image, a link to a web page, and an email link; and

a viewer built-in to the rich media file to display the information on the computer system,

wherein the client identifier, the unique identifier, the version number, the print module, the viewing limits, the update offer, the requester, the information to be displayed, and the built-in viewer comprise a single file.

The Examiner states that Leonard, at figure 7, column 15, lines 4-20, and column 8, lines 16-34, teaches “a rich media file stored in a machine-readable medium, comprising a client identifier to identify a creator of the rich media file; a unique identifier to identify the rich media file; [and] a version number identifying a version of the rich media file,” as set forth in claim 52 (*see, e.g.*, Office Action, page 14). The cited columns and lines of Leonard do not relate to these elements, nor do any other portions of Leonard or Martin teach these elements of claim 52. In column 15, lines 4-20, Leonard discusses “transmitting the message to the installed viewer applet 7 on the forwarded message recipient’s computer 8” (*see, e.g.*, lines 14-16). The cited column and lines reinforce the notion that the message and the viewer applet were not designed to comprise a single file. Further, Leonard fails to teach, whether at these columns and lines or otherwise, “a client identifier to identify a creator of the rich media file,” a “unique identifier,” nor a “version number identifying a version of the rich media file,” as set forth in claim 52.

At column 8, lines 16-34, Leonard teaches that a central server may be used “to track all persons to whom the message has been forwarded” (*see, e.g.*, lines 31-32). The Applicant submits that tracking to whom a message is forwarded is not the same as “a client identifier to

identify a creator of the rich media file,” a “unique identifier,” nor a “version number identifying a version of the rich media file,” as set forth in claim 52. Indeed, neither Leonard nor Martin use the terms “client identifier,” “creator,” “unique identifier,” or “version number.” Although not cited by the Examiner, Leonard teaches a “sender identifier . . . followed by an RCPT command, which identifies the recipient as the central mail server” (*see, e.g.*, Leonard, column 17, lines 61-64). But a sender of a message is not necessarily its creator. As such, a “sender identifier” is not a “client identifier to identify a creator of the rich media file,” as set forth in claim 52. The term “originator” is used throughout Leonard, but not in the context of an identifier.

The Examiner further suggests that “a print module to enable printing of the rich media file if included by the creator of the rich media file and to disable printing if excluded by the creator” is taught at column 14, lines 9-55 of Leonard. But the cited column and lines do not refer to or suggest printing of any kind. To the best of Applicant’s understanding, the Examiner intended to refer to column 15, lines 33-36, which state “prevention of copying or printing of the message would normally be carried out by disabling (or conversely by not enabling) copy or print functions of the viewer applet 4.”

While Leonard might allow the viewer applet itself to enable or disable a print function, such functionality is different from including or excluding a print module. One of the problems of the prior art is the bulky nature of viewers. It is not uncommon for a user to have to wait minutes for a particular viewer to load and execute prior to displaying the desired information. Certain embodiments of the present disclosure overcome such disadvantages. For example, as set forth in the present disclosure, “[i]f the client chooses to exclude modules like printing module 225, rather than just disabling the code for these modules, the code for these modules is excluded from rich media file 130. This helps keep rich media file 130 at its smallest size” (*see* specification, page 6, lines 5-7).

The Examiner further argues that Leonard teaches “a first dialogue box structured to appear responsive to viewing limits of the rich media file, the first dialogue box to communicate to a user an invitation to access another rich media file” at figure 4 and column 15, lines 30-60. But if the “Main Message Screen” of figure 4 is the first dialogue box of claim 52, then the first dialogue box is not structured to appear responsive to viewing limits of the rich media file. To be sure, the Main Message Screen has features which “resemble those of the conventional electronic mail client” (*see, e.g.*, Leonard, column 19, lines 5-6). While buttons or menu items

of the Main Message Screen are disabled or otherwise indicated on the Main Message Screen, which arguably constitute “viewing limits,” this is not to say that the Main Message Screen itself (i.e., the alleged “dialogue box”) is caused to appear responsive to the viewing limits, as set forth in claim 52. Rather, the Main Message Screen has previously appeared irrespective of any viewing limits; thereafter, the “viewing limits” are implemented (i.e., the buttons or menu items are then disabled). Further, the Main Message Screen of figure 4 does not communicate to a user an invitation to access another rich media file, as set forth in claim 52.

The Examiner next suggests that Leonard teaches “a second dialogue box structured to appear responsive to an update offer, the second dialogue box for prompting the user of the rich media file to check for a newer version of the rich media file” at figure 5 and column 15, lines 30-60. The cited column and lines do not mention a “version” of any sort. With respect to checking for newer versions of the rich media file, the Examiner has previously cited column 13, lines 32-55, which teaches that control of the messages (lifespan, handling, and wrapper) can be “directed to versions of the message received by recipients in a particular subspace” (*see, e.g.*, Office Action dated February 9, 2007, page 7). But even if this was the Examiner’s intention, Leonard fails to teach checking to see if there is a newer version of a message. And if the “Message Preparation Screen” of Leonard, figure 5 is the second dialogue box of claim 52, then the second dialogue box is not structured to appear responsive to an update offer, let alone to prompt the user of the rich media file to check for a newer version of the rich media file, as set forth in claim 52.

Similarly, Leonard fails to teach “a requester structured to retrieve the newer version of the rich media file responsive to an action by the user according to the update offer.” While Leonard describes retrieving “information or portions of the message from the central server each time the message is to be viewed or handled . . .” (*see, e.g.*, Leonard, column 8, lines 16-20), if the “portions of the message” are the rich media file of claim 52, then a newer version of the rich media file is not retrieved; instead, Leonard merely retrieves portions of the already existing message. In other words, the central server stores a single message, and the portions are merely parts of the single message. A part of an already existing message does not constitute a newer version of the message, but rather a component of the single whole message stored on the central server. Furthermore, nowhere in Leonard is it suggested that retrieving a newer version happens responsive to the update offer.

The Examiner suggests that Leonard teaches “information to be displayed on a computer system, the information including text, at least one still image, and structured to include at least one of an animated image, a link to a web page, and an email link” at column 12, lines 18-67. But this citation discusses various control options, such as an “oops” button, lifespan, encryption, and other controls (*see, e.g.*, Leonard, column 12, lines 50-67). Nowhere in Leonard is an animated image, a link to a web page, or an email link ever discussed or disclosed.

Finally, the Examiner argues that Leonard teaches “a viewer built into the rich media file to display the information on the computer system, wherein the client identifier, the unique identifier, the version number, the print module, the viewing limits, the update offer, the requester, the information to be displayed, and the built-in viewer comprise a single file.” Several citations are given (referring to Leonard, sample figures 4-6, column 14, lines 9-55, and column 15, lines 30-60). But none of these portions of Leonard disclose the viewer built-in to the rich media file to display the information, much less the client identifier, the unique identifier, the version number, the print module, the viewing limits, the update offer, the requester, the information to be displayed, and the built-in viewer comprising a single file, as set forth in the present application and claim 52.

Martin fails to remedy the deficiencies of Leonard, with respect to these teachings. Therefore, Leonard and Martin, whether individually or in combination with one another, fail to teach all of the limitations of claim 52.

IV. Leonard and Martin fail to teach each of the limitations of claim 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51.

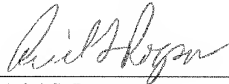
The Applicant incorporates by reference previous arguments made with respect to claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51. As explained above, the combination of Martin with Leonard is improper and would render the important features of Leonard inoperable. Further, certain features of claim 52, as argued above, can be found variously in claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51: the arguments made above apply equally to these claims as well. For at least this reason, claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51 are allowable. In addition, because Leonard and Martin fail to teach each of the limitations of each of the claims—whether individually or in combination—the claims are allowable. Thus, the Applicant respectfully asks for reconsideration in light of the above remarks.

V. Conclusion

For the foregoing reasons, allowance of claims 1-4, 6-7, 9-17, 20-42, 44, 46-48, and 51-52 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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A handwritten signature in cursive script, appearing to read 'Ariel S. Rogson', is written over a horizontal line.

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